

IN THE UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF OHIO

- - -

SHIELDMARK, INC.,)

Plaintiff,)

vs.) 1:12-CV-00223-DCN

INSITE SOLUTIONS,) Judge Donald C. Nugent

Defendant.)

- - -

Deposition of JERRY M. SERRA, Ph.D., a
Witness herein, called by the Defendant for
cross-examination pursuant to the Federal
Rules of Civil Procedure, taken before me,
the undersigned, Michael G. Cotterman, a
Notary Public in and for the State of Ohio,
at 106 South Main Street, 4th Floor, Akron,
Ohio, on Friday, the 30th day of August,
2013, at 10:50 o'clock a.m.

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ALSO PRESENT:

Thomas R. Goecke

Cliff Lowe

Eric Gaum

I N D E X

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1 JERRY M. SERRA, Ph.D.
2 of lawful age, a Witness herein, called for
3 examination, as provided by the Rules of
4 Civil Procedure, being by me first duly
5 sworn, as hereinafter certified, deposed and
6 said as follows:

7 - - -

8 CROSS-EXAMINATION

9 BY MR. WEBER:

10 Q. Would you state your name for the
11 record please.

12 A. Jerry M. Serra.

13 Q. Okay. And Mr. Serra, you've been
14 retained by ShieldMark in the matter that
15 brings us together; is that correct?

16 A. Yes.

17 Q. When were you retained by ShieldMark?

18 A. About a year ago, I don't have the
19 exact date but I'd say it was about a year
20 ago.

21 Q. And that was to be an expert in this
22 case, correct?

23 A. Yes.

24 Q. Do you have any prior relationship
25 with ShieldMark?

1 A. No.

2 Q. Okay. So the first time you ever had
3 any involvement with ShieldMark was a year
4 ago; is that correct?

5 A. Yes.

6 Q. And when I use the term ShieldMark,
7 did you also understand that to include Mr.
8 Goecke, Tom Goecke?

9 A. Yes, when I saw the patent, I saw his
10 name on the patent.

11 Q. Okay. So just to be clear, you had
12 no relationship with Mr. Goecke, with
13 ShieldMark, with this, with the patent in
14 suit, the '480 patent or its application
15 before the Patent Office prior to about a
16 year ago; is that correct?

17 A. Correct.

18 Q. Okay. And who contacted you on
19 behalf of ShieldMark?

20 A. I believe it was Scott.

21 Q. Okay. Scott Harders?

22 A. Yes.

23 Q. Okay. And were you --

24 A. Well, actually the Pressure Sensitive
25 Tape Council gave me Scott's name and said

1 they were looking for someone that could help
2 them with a case, and then I called Scott and
3 that's how we got connected.

4 Q. Okay. So you called Scott and what
5 did you understand Scott was looking for?

6 A. An expert witness that could look at
7 some -- a patent and help him understand the
8 patent from a technical perspective.

9 Q. Okay. Did you understand -- what did
10 you -- well, strike that.

11 Were there any particular
12 issues that he raised with you at the onset
13 with regard to understanding the patent or
14 the technology?

15 A. No, it was fairly, our first
16 discussion was fairly vague. And then when
17 we decided that we'd go into, that they'd
18 bring me on to help them, I got the copy of
19 the patent. And that's when I started to
20 really understand the detail, once I read the
21 patent.

22 Q. Okay. And what was the first issue
23 -- well, strike that.

24 I assume that you've become
25 involved in various issues that surround the

1 '480 patent; is that correct.

2 A. Yes, it was -- yes.

3 Q. What was the first issue that you
4 recall?

5 A. The very first one, oh, boy, I'm
6 trying to remember what it was.

7 Q. Well, can you just share with me
8 issues that you recall?

9 A. Well, we talked about --

10 MR. COHN: Well, wait.

11 MR. WEBER: That bear upon the
12 '480 patent.

13 MR. COHN: And let me object to
14 the extent you're asking for conversations
15 between Scott Harders and Dr. Serra and I
16 asked Dr. Serra not to -- he can certainly
17 answer the question without talking about the
18 conversation.

19 BY MR. WEBER:

20 Q. Yeah, I just want your understanding,
21 I don't want -- you don't have to tell me
22 what Mr. Harders said to you, I just want to
23 know your understanding of the issues that,
24 that you've been involved with with regard to
25 the '480 patent?

1 A. You want the big picture or do you
2 want the first?

3 Q. Well, let's start with the big
4 picture and then we'll focus in on the plants
5 and the flowers and the bees and the other
6 things that are in the picture.

7 A. We started, when I got the patent
8 then it was reading the patent. And it
9 boiled down to, if I could summarize it
10 quickly, it boiled down to looking at the
11 claims relative to the construction of the
12 product and relative -- well, it was mostly
13 around the construction, meaning the
14 thickness.

15 And then the claim language,
16 explaining the claim language from, from my
17 perspective as an expert in the field. And
18 I would say that's where we started.

19 Q. Okay. When you say the construction
20 of the product, what product are you talking
21 about?

22 A. It was the product described in the
23 '480 patent.

24 Q. Did you actually have a product that
25 you were looking at?

1 A. Not at that time.

2 Q. Okay. Let's jump back just a little
3 bit, have you ever been deposed before?

4 A. No, sir.

5 Q. I assume you've been told a little
6 about what to expect here and been told what
7 a nice guy I am?

8 A. Very nice.

9 Q. And how smoothly this was going to
10 go?

11 MR. COHN: I think it was
12 deceptively nice.

13 BY MR. WEBER:

14 Q. You understand you are under oath?

15 A. Yes.

16 Q. And that a record is being made of
17 these proceedings?

18 A. Yes.

19 Q. And you understand that your
20 testimony is given subject to penalty of
21 perjury?

22 A. Yes.

23 Q. Okay. Is this the first case in
24 which you've been, is this the first patent
25 case in which you've been involved?

1 A. In the sense of?

2 Q. Being an expert witness?

3 A. I've been involved with patent cases
4 with my former employer, that was part of my
5 job, but not as an independent from, you
6 know, independent of my former company, no,
7 this is the first time.

8 Q. Okay. And you issued an expert
9 report in this matter, correct?

10 A. I've issued a few, yes.

11 Q. Okay. Well, you've only issued one
12 in the matter of this litigation as an expert
13 report, is that fair to say?

14 A. I can't answer that. All I know is
15 I've issued several declarations and a couple
16 reports and without looking at them I can't
17 say which, where they went.

18 MR. WEBER: Let me ask counsel,
19 there is just one expert report though that
20 he offered?

21 MR. COHN: I think the
22 declarations also disclose opinions, so I
23 think that, whether everything is contained
24 in one document, he's provided several
25 documents that describe his work and

1 findings.

2 MR. WEBER: How many reports did
3 he prepare in accordance with Federal Civil
4 Rule 26, that's my question?

5 MR. COHN: I think they could all
6 be said to comply with that federal rule.

7 MR. WEBER: Well, all right, we
8 may have a problem down the road if you're
9 saying he's going to testify with regard to
10 matters other than what was presented in his
11 expert report of June 20th, 2013, are you
12 telling me that?

13 MR. COHN: Well, he may, yes, but
14 it won't be anything he hasn't disclosed to
15 you either in documents or the other
16 declarations.

17 MR. WEBER: I'm not deposing him
18 as a fact witness and I'm not deposing him
19 with regard to --

20 MR. COHN: The declarations he
21 submitted were as an expert.

22 MR. WEBER: As an expert before
23 the Patent Office?

24 MR. COHN: No, I think he
25 submitted some in connection with motions

1 that were pending in this Court and those are
2 the ones to which I am referring.

3 MR. WEBER: Okay.

4 BY MR. WEBER:

5 Q. The expert report that you authored
6 on or that you signed on or about June 20th,
7 2013, do you recall that one?

8 A. Yes.

9 Q. Okay. You've reviewed that before
10 coming here today?

11 A. Yes, I read it rather quickly.

12 Q. And how was that report -- well, in
13 fact did you write this report, the report of
14 June 20th, 2013?

15 MR. COHN: Isn't that a question
16 you want me to ask?

17 MR. WEBER: No, it's more artfully
18 presented.

19 BY MR. WEBER:

20 Q. Did you write the report of June
21 20th, 2013?

22 A. No, I did not physically write the
23 report.

24 Q. Okay, did you type it?

25 A. No.

1 Q. But you reviewed it before signing it
2 I assume, correct?

3 A. Yes.

4 Q. And it is your report?

5 A. Yes.

6 Q. And if called upon you will testify
7 in accordance with and consistent with that
8 report; is that correct

9 A. Yes.

10 Q. Okay. I asked you a moment ago
11 about, you know, some of the issues and you
12 said the first one was with respect to claim
13 language and the product. What were some of
14 the other issues, the next issue that you
15 recall?

16 A. We talked about, the really first
17 details that we got into were, as I said
18 before, trying to understand the construction
19 and trying to understand what the language
20 meant. Then also we talked about peel
21 adhesion, how it's measured and the
22 differences and methods.

23 Then from what I can recall
24 we, we had some, I don't know what the word
25 was, someone wanted to look at the claim

1 language and rewrite them so we talked about
2 that.

3 Then, then we really focused
4 more on what I've already said to you,
5 without repeating myself, the construction
6 and the, by construction I mean the thickness
7 and the entire product. The hardness was
8 also something we discussed and peel
9 adhesion and that's primarily what it focused
10 around.

11 Q. Okay. You said you worked on issues
12 regarding rewriting the claim language, when
13 was that?

14 A. You know, from memory I'm going to
15 say it was probably two months, three months
16 into it.

17 Q. Okay.

18 A. There was, by that there was, I
19 believe there was another law firm that was
20 proposing new language and I was asked to
21 comment on that.

22 Q. Okay. Have you -- strike that.

23 You're aware that the '480
24 patent is undergoing a re-examination, is
25 that fair to say?

1 A. Yes.

2 Q. Okay. Have you been kept advised in
3 that regard?

4 A. More or less. I would say yes in
5 that yesterday I reviewed some documents on
6 the re-exam.

7 Q. Okay.

8 A. Up until yesterday I hadn't seen
9 them.

10 Q. You hadn't seen those documents?

11 A. No.

12 Q. You had seen other documents though
13 in the re-exam, hadn't you?

14 A. I'm not sure I could say yes to that.
15 I'd have to really go back and look, I don't
16 think I've seen documents, what I saw
17 yesterday I had not seen.

18 Q. And there was a, a patent application
19 that continued on from the '480 patent that
20 ultimately issued into another patent, do you
21 recall that?

22 A. I'm going to have to say I don't
23 remember seeing it. I'm not saying I didn't
24 see it, I'm saying at this point I can't
25 recall seeing that.

1 Q. Apart from yesterday, were you
2 previously provided with copies of any Patent
3 Office actions in the re-exam and asked to
4 comment on them?

5 A. I did see some Patent Office actions
6 but I don't know if that was related to the
7 re-exam, that might have been in the history
8 of the initial patent.

9 Q. Okay. Did you provide comments or
10 suggestions on how to respond to the office
11 action?

12 A. I don't recall that I did.

13 Q. Did you see drafts of responses to
14 the office action?

15 A. I did not see drafts.

16 MR. WEBER: Okay, I'll ask you to
17 mark this as 52.

18 (Defendant's Exhibit
19 No. 52 was marked
20 for identification.)

21 BY MR. WEBER:

22 Q. I'll hand you what's been marked as
23 Exhibit 52, do you recall seeing that
24 document?

25 A. Let me take a couple seconds to look

1 through it.

2 Q. Sure, take all the time you need to
3 look at it.

4 A. (Doing as requested.)

5 Q. To help you in your review, maybe to
6 refresh your memory, this is the document by
7 which the Court construed certain claim
8 terms.

9 A. I did see the results of the terms by
10 the Court.

11 Q. Okay. Did you see them in this
12 document?

13 A. You know, I'll have to tell you I
14 can't recall, I'd have to go back and look
15 to see if I have this document. But I did
16 see the definition of this, I think I did
17 see it but I'm not a hundred percent sure
18 without going back through my own documents.

19 Q. And you didn't bring your files with
20 you?

21 A. I brought some of the files with me;
22 I know I did not bring this one.

23 Q. Okay. I'd like for you to look at
24 page six of this document, although you can
25 take whatever time you need.

1 A. No, that's okay.

2 Q. Page six, look down at the paragraph
3 that bridges pages six and seven.

4 A. "The '480 patent..."

5 Q. Correct. And you have read and
6 studied the '480 patent quite extensively,
7 haven't you?

8 A. I've looked at it many times.

9 Q. And the Court here says the '480
10 patent distinguishes between a, quote, layer
11 of adhesive, quote, and a, quote,
12 double-sided adhesive layer, period, quote,
13 do you see that?

14 A. Uh-huh.

15 Q. Do you agree with the Court's
16 assessment of the '480 patent in that
17 regard?

18 A. Distinguishing between those two
19 words, two quotes?

20 Q. Right, that the patent distinguishes
21 between a layer of adhesive and a
22 double-sided layer?

23 MR. COHN: I would suggest that in
24 fairness you put the patent in front of him
25 also.

1 MR. WEBER: Sure, I'd be happy to
2 do that. I would have thought as short as
3 the patent is he would have had it memorized
4 by now, but we'll do that.

5 MR. COHN: I don't trust his
6 memory.

7 (Defendant's Exhibit
8 No. 53 was marked
9 for identification.)

10 BY MR. WEBER:

11 Q. Now you have in front of you a copy
12 of the '480 patent, correct?

13 A. Yes.

14 Q. And do you still agree with the Court
15 when the Court said the '480 patent
16 distinguishes between a layer of adhesive and
17 a double-sided adhesive layer?

18 A. Okay.

19 Q. You agree with that, correct?

20 A. Yes.

21 Q. And do you, reading the next
22 sentence, do you agree with the Court when
23 the Court said, "The inventor clearly used
24 different terms to describe different
25 concepts related to the adhesive"?

1 A. I can't comment on what the inventor
2 was thinking.

3 Q. No, well, the Court is not saying
4 what the inventor was thinking, it says,
5 "The inventor clearly used different terms
6 to describe different concepts related to
7 the adhesive," do you agree with the Court?

8 MR. COHN: I object, he answered
9 that.

10 MR. WEBER: Go ahead, you can
11 answer.

12 THE WITNESS: Say that again
13 please.

14 MR. WEBER: Do you agree with the
15 Court's statement that "The inventor clearly
16 used different terms to describe different
17 concepts related to the adhesive"?

18 MR. COHN: Objection.

19 THE WITNESS: Just one second
20 please.

21 Okay, yeah.

22 BY MR. WEBER:

23 Q. You do agree with the Court,
24 correct?

25 A. Yes.

1 Q. Okay. Turning to page seven, the
2 first full paragraph, first sentence of the
3 first full paragraph on page seven of the
4 Court's order of Exhibit 52 the Court says,
5 If the Court were to adopt ShieldMark's
6 argued interpretation, the choice of
7 distinguishing claim two's, quote,
8 double-sided adhesive layer, quote, from
9 the, quote, adhesive material, quote, in
10 claims one and five would be rendered
11 superfluous, end of quote, did I read that
12 correctly?

13 MR. COHN: Objection.

14 THE WITNESS: You read it
15 correctly but I'm not sure I understand what
16 he's saying.

17 BY MR. WEBER:

18 Q. You don't understand what the Court
19 was saying when it was construing --

20 A. No, I understand the Court's
21 description of a double-sided adhesive
22 layer, I understand that. What I don't
23 understand is the next sentence, that it's
24 superfluous, what is he saying, what is the
25 Court saying?

1 Q. Well, the Court I think is saying --
2 well, in fact I'm not going to tell you what
3 I think the Court is saying because the Court
4 said it quite well.

5 But you understand that the
6 adhesive portion of the invention of the
7 '480 patent is described in different ways
8 in different claims of the patent, don't
9 you?

10 MR. COHN: Objection.

11 THE WITNESS: Okay.

12 BY MR. WEBER:

13 Q. You understand that?

14 A. Okay.

15 Q. You don't argue it's not described
16 differently in different claims, do you?

17 MR. COHN: Objection.

18 MR. WEBER: And you need to answer
19 audibly.

20 THE WITNESS: I'm sorry, go ahead
21 and ask it again?

22 BY MR. WEBER:

23 Q. I mean you agree that the adhesive
24 element of the invention of the '480 patent
25 is described differently in different

1 claims?

2 A. Yes.

3 Q. Okay. I'd like for you to turn to
4 page eight of the Court's order and go down
5 about one, two, three lines from the top and
6 over at the end where it starts "The only,"
7 I'm going to read what the Court said there
8 and ask you if you agree with that.

9 The Court said, quote, the only
10 way to give meaning to the term, quote,
11 double-sided adhesive layer, quote, and to
12 differentiate it from the term, quote, layer
13 of adhesive material, quote, is to accept
14 Insite's construction of the term which
15 requires that an adhesive layer be present on
16 both sides of a center layer of non-adhesive
17 material.

18 MR. COHN: Objection.

19 MR. WEBER: End of quote.

20 MR. COHN: That's not correct.

21 MR. WEBER: What did I read wrong?

22 MR. COHN: You added a word.

23 MR. WEBER: What word did I add?

24 MR. COHN: Layer.

25 MR. WEBER: I'm going to read it

1 again, okay.

2 BY MR. WEBER:

3 Q. Do you agree with the Court's
4 statement that, quote, the only way to give
5 meaning to the term, quote, double-sided
6 adhesive layer, quote, and to differentiate
7 it from the term, quote, layer of adhesive
8 material, quote, is to accept Insite's
9 construction of the term which requires that
10 an adhesive be present on both sides of a
11 center layer of non-adhesive material, end of
12 quote?

13 A. I do.

14 Q. Okay. And you agree with the Court
15 in that regard, don't you?

16 MR. COHN: Objection.

17 THE WITNESS: Yes.

18 BY MR. WEBER:

19 Q. And then bridging pages eight and
20 nine at the bottom, the sentence that bridges
21 those pages, the Court said the term, quote,
22 double-sided adhesive layer, quote, in claim
23 two, therefore, is to be defined as, quote, a
24 layer of non-adhesive material with adhesive
25 on both sides, end of quote, did I state that

1 correctly?

2 A. Yes.

3 Q. Okay. And you have looked at and
4 carefully examined the accused product in
5 this case, haven't you?

6 A. I've looked at one product.

7 Q. Okay. And you were told that was the
8 accused product?

9 A. Yes.

10 Q. And that product does not have a
11 layer of non-adhesive material with adhesive
12 on both sides, does it?

13 A. That's correct.

14 Q. So to find infringement of that
15 product you had to disregard the requirement
16 of a layer of non-adhesive material, isn't
17 that correct?

18 MR. COHN: Objection.

19 THE WITNESS: Can you state that
20 again?

21 MR. WEBER: To find infringement
22 you disregarded the requirement of a layer
23 of non-adhesive material, isn't that
24 correct?

25 MR. COHN: Objection.

1 THE WITNESS: No.

2 BY MR. WEBER:

3 Q. Okay, you did not, okay. Did the
4 claims that just required an adhesive layer
5 require a layer of non-adhesive material?

6 MR. COHN: In what?

7 MR. WEBER: Of the '480 patent?

8 MR. COHN: Objection.

9 THE WITNESS: That's not what it
10 said here.

11 MR. WEBER: No, I'm asking you,
12 did the claims that just recited an adhesive
13 layer, did those claims require a layer of
14 non-adhesive material?

15 MR. COHN: Objection.

16 THE WITNESS: An adhesive layer
17 can also be a layer that's a double-sided
18 layer.

19 MR. WEBER: Now would you answer
20 my question?

21 THE WITNESS: State it again
22 please.

23 MR. WEBER: Would you read it
24 back.

25 (Previous testimony read back as requested.)

1 MR. COHN: Objection.

2 MR. WEBER: You can go ahead and
3 answer.

4 THE WITNESS: I'm going to say no.

5 BY MR. WEBER:

6 Q. In order to find infringement you do
7 not distinguish between a layer of adhesive
8 and a double-sided adhesive layer, do you?

9 MR. COHN: Objection.

10 THE WITNESS: I'm trying to think
11 how I can answer that.

12 BY MR. WEBER:

13 Q. Truthfully.

14 A. Well, absolutely, but it's not quite
15 as simple as that.

16 Yes, I do, when I looked at
17 this from the perspective of infringement,
18 yes, the '480 patent has the double-sided
19 tape, as we call them in the industry, and
20 yes, it has the adhesive layer.

21 When I looked at that, it's
22 obvious that a single layer of adhesive is
23 not the same as a double layer of adhesive,
24 however, the functionality of the two are the
25 same.

1 Q. Did you in writing your opinion
2 understand when you can and when you cannot
3 use the Doctrine of Equivalents?

4 A. No.

5 Q. Nobody ever shared that with you, did
6 they?

7 A. I'm going to say no.

8 Q. Okay. You understand that the Court
9 said that there had to be a non-adhesive
10 material, didn't you?

11 MR. COHN: Objection.

12 THE WITNESS: No, I understood the
13 definition of what they said but I didn't
14 understand that they said you have to have
15 this, have to have the double-sided.

16 BY MR. WEBER:

17 Q. Your goal was to find infringement,
18 wasn't it?

19 A. No, my goal was to review this and
20 give my opinion of what I thought, what I was
21 reading.

22 Q. You knew they had filed a case to
23 charge that product with infringement, didn't
24 you?

25 A. Yes, I did.

1 Q. Okay. And how much are you being
2 paid for this?

3 A. It's in there, it's four hundred
4 dollars an hour.

5 Q. Do you do consulting work otherwise?

6 A. Yes.

7 Q. And what's your rate for that?

8 A. My normal rate is two hundred dollars
9 an hour.

10 Q. But it's four hundred dollars to give
11 this kind of testimony; is that correct?

12 A. Correct.

13 Q. And why?

14 A. To be quite honest with you, I have
15 some friends who are patent attorneys that
16 I've worked with through the years and I
17 asked what's the rate for expert witnesses
18 and that's how I came up with the number.

19 Q. If the Court had said -- well, strike
20 that.

21 If you had understood the Court
22 to say that claim two requires a layer of
23 non-adhesive material, there would be no
24 infringement, is that fair to say?

25 MR. COHN: Objection.

1 THE WITNESS: That's fair to say.

2 MR. WEBER: Okay.

3 MR. COHN: Now that he's answered
4 your question and I can't be accused of
5 coaching, by that question did you mean to
6 include the Doctrine of Equivalents that the
7 Court said didn't apply?

8 MR. WEBER: My question is what my
9 question is.

10 MR. COHN: Your question is vague.

11 MR. WEBER: No, my question was
12 about as pointed as it could be and so was
13 his answer.

14 MR. COHN: I disagree.

15 MR. WEBER: Well, you and I,
16 that's how lawyers make their money.

17 MR. COHN: Right.

18 MR. WEBER: And I don't make four
19 hundred dollars an hour.

20 MR. COHN: Neither do I. But I
21 objected after the question was answered, I
22 thought I would give you the reason for my
23 objection.

24 MR. WEBER: That's not the first
25 time you've done that, but I appreciate it,

1 that's the first time in the last few days.

2 MR. COHN: I always ask your
3 permission before I say anything.

4 MR. WEBER: I'm just sparring with
5 you.

6 MR. COHN: Well, that particular
7 comment was an insult.

8 MR. WEBER: Well, okay, if you
9 were insulted I apologize because I was
10 trying not to.

11 MR. COHN: We'll get through it,
12 my skin is thick.

13 MR. WEBER: I think it is and it
14 gets thicker as we get older.

15 BY MR. WEBER:

16 Q. Okay. Now, you're familiar with the
17 term "substantially uniform thickness" as
18 used in claim five, aren't you?

19 A. Yes.

20 Q. And if you look at page eleven now
21 of the Court's order, Exhibit 52, down at
22 the bottom, in fact the last sentence on the
23 page says the term, quote, substantially
24 uniform thickness, quote, as used in claim
25 five is, therefore, defined as, quote, a

1 largely but not necessarily wholly uniform
2 distance between the upper surface and the
3 lower surface without significant deviations,
4 protrusions, or steps, end of quote, did I
5 read that correctly?

6 A. Yes.

7 Q. And you understood the Court's ruling
8 in that regard, correct?

9 A. Yes.

10 Q. Okay. And in claim five, that phrase
11 that we just read describes a polymer layer,
12 correct?

13 A. Yes.

14 MR. WEBER: Okay. Mark this as
15 the next exhibit.

16 (Defendant's Exhibit
17 No. 54 was marked
18 for identification.)

19 BY MR. WEBER:

20 Q. Now, do you recognize Exhibit 54?

21 A. Yes.

22 Q. And this was the report you authored
23 under Federal Rule 26, correct?

24 A. Yes.

25 Q. Okay. And Local Patent Rule 5.1(b),

1 correct?

2 A. Yes.

3 Q. So you have a Ph.D.?

4 A. Uh-huh.

5 Q. In what?

6 A. Biological sciences.

7 Q. Biological?

8 A. Yes, with a major in organic
9 chemistry, analytical chemistry.

10 Q. Is analytical chemistry P chem?

11 A. No, P chem was physical chemistry.

12 Q. Okay.

13 A. They're related but it's different.

14 Q. So you have a Ph.D. in biological
15 science with some concentration on organic
16 and analytical chemistry?

17 A. Yes.

18 Q. And you have forty years of
19 experience in the polymer slash adhesive tape
20 industry, correct?

21 A. Yes.

22 Q. And down in the last paragraph there
23 you say -- I mean the last sentence in the
24 first paragraph of Exhibit 54 you say, quote,
25 I consider myself to be a person of ordinary

1 skill in the art of adhesive tapes and
2 adhesive technologies, end of quote, did I
3 read that correctly?

4 A. Yes.

5 Q. Okay. Is that your belief?

6 A. Yes.

7 Q. What would be the education level and
8 experience of a person of extraordinary skill
9 in the art?

10 A. What I have.

11 Q. But what are you, are you a person
12 of ordinary skill in the art or a person of
13 extraordinary skill?

14 MR. COHN: Objection.

15 THE WITNESS: With you I'm being
16 modest.

17 BY MR. WEBER:

18 Q. You're being modest?

19 A. Yes.

20 Q. So in your report you're trying to be
21 modest, is that your testimony?

22 A. Yes.

23 Q. Over on page four of your report
24 you're talking about a Shore A hardness of
25 between 92 to 100, correct?

1 A. Yes.

2 Q. And here you were testing the accused
3 product; is that correct?

4 A. I was not testing, I was reading the
5 report.

6 Q. Okay, I apologize, you were assessing
7 the report. You say that the Chemsultants
8 report had a hardness in the specified range
9 of 92 to 100?

10 A. That's what they said.

11 Q. That's what they said?

12 A. Yes.

13 Q. Okay. And based on those reports you
14 concluded that those tapes include a polymer
15 layer having a Shore A hardness of between 92
16 to 100, correct?

17 A. Correct.

18 Q. Do you know exactly what the Shore A
19 hardness was, was it between 92 and 100?

20 A. I saw the report said it was in that
21 range so that's what I used; I didn't get the
22 exact number.

23 Q. Did you run any independent tests?

24 A. No, I did not.

25 Q. Okay. Do you know what the

1 temperature was at the time those tests were
2 run?

3 A. I can say for Chemsultants what it
4 was, only because I know they are an A2LA
5 accredited lab, as is the ARD lab, I can also
6 say they are an ISO certified lab, they are
7 recognized as very reliable labs throughout
8 the U.S.

9 And Chemsultants follows the, I
10 know Chemsultants because I've been there and
11 their laboratory is standard laboratory
12 conditions, which are roughly 72 to 73
13 degrees Fahrenheit.

14 Q. So you can assume what the
15 temperature was, correct?

16 A. Right.

17 Q. You don't know what the temperature
18 was?

19 A. I don't know for a fact, but knowing
20 Chemsultants and the way they do business,
21 it's very probable it was held at the
22 standard lab temperature.

23 Q. But you just relied on what they
24 did, you didn't run any test to know they
25 adhered to these standards that you just

1 recited?

2 A. No, I did not, I just read the
3 report.

4 Q. Okay. And those tests are
5 temperature sensitive, aren't they?

6 A. Absolutely.

7 Q. And do you know what the dwell time
8 was for those tests?

9 A. Generally, generally --

10 Q. No, I want to know, do you know what
11 the dwell time was for the tests?

12 A. I know what's required; I don't know
13 if they actually followed that.

14 Q. Thank you. And you didn't run
15 tests?

16 A. No.

17 Q. So you can't tell me what the dwell
18 time or the temperature was?

19 A. No, but that's a phone call.

20 Q. Well, that's a phone call for some
21 hearsay from you, right?

22 MR. COHN: Objection.

23 THE WITNESS: No, it's a phone
24 call to the lab asking them to state what the
25 conditions were and then it's done.

1 BY MR. WEBER:

2 Q. Okay. Still on page four of your
3 report, it says figure one below shows a
4 cross-sectional view of the accused Superior
5 Mark adhesive tape, do you see that
6 paragraph?

7 A. Uh-huh.

8 Q. And you determined that ninety-five
9 percent of that product has the polymer layer
10 with a thickness literally in the claimed
11 range?

12 A. Uh-huh.

13 MR. COHN: Objection, you're
14 quoting it and didn't do it correctly.

15 BY MR. WEBER:

16 Q. Well, I wasn't quoting but was it
17 literally in the claimed range?

18 A. Yes.

19 Q. And ninety-five percent of it was
20 within that range and where was that
21 ninety-five percent?

22 MR. COHN: Objection, you have a
23 preface to the question that you didn't give
24 him a chance to disagree with.

25 MR. WEBER: You said more than

1 ninety-five percent, was that your problem?

2 MR. COHN: It is.

3 BY MR. WEBER:

4 Q. Okay, more than ninety-five percent?

5 A. Okay, if you take, and I took it from
6 Mr. Cliff Lowe's declaration which is, I
7 don't know if you have it here, but he gave
8 examples of two inches, four inches and six
9 inches.

10 If you take the six inches and
11 take it where that center portion is, I
12 forget the exact dimensions but you divide
13 that by the total and you get ninety-five
14 something. If you do it for the four inches
15 you get ninety-four point something and if
16 you do it for two inches you get something,
17 so I took it from his report.

18 Q. All right. So you, you measured the
19 thickness because that's what this claim
20 limitation is all about, right, it's the
21 thickness of the polymer layer; is that
22 correct?

23 A. Yes.

24 Q. And we'll look in the patent.

25 A. Yes.

1 Q. Okay, you agree with that, okay. So
2 you measured the thickness?

3 A. I took Mr. Lowe's information and
4 used his information.

5 Q. Okay.

6 A. I measured.

7 Q. Length?

8 A. Yes. But I also measured weight and
9 I also measured, calculated an area.

10 Q. Okay, the patent doesn't say
11 anything about weight, does it, as far as a
12 way to measure the thickness of the polymer
13 layer?

14 A. No.

15 Q. Okay.

16 A. However -- may I comment?

17 Q. No. I mean your answer is no, it
18 doesn't?

19 A. Right.

20 Q. It doesn't saying anything about area
21 either, does it?

22 A. That's correct.

23 Q. And typically in measuring thickness
24 you measure it in what unit?

25 A. In the adhesive industry in mils.

1 Q. Okay. And in the English system that
2 would be thousandths of an inch; is that
3 correct?

4 A. Yes, .001 inches is one mil.

5 Q. Okay. And that's how almost any
6 right thinking person would measure
7 thickness, right, it's a linear measurement?

8 MR. COHN: Objection.

9 THE WITNESS: Not necessarily.

10 BY MR. WEBER:

11 Q. The patent doesn't tell you to
12 concern yourself with cross-sectional area,
13 does it?

14 A. Correct.

15 Q. The patent doesn't tell you to
16 concern yourself with weight or mass of the
17 polymer layer, does it?

18 A. Correct.

19 Q. But yet that's what you chose to
20 measure?

21 A. Yes.

22 Q. Was that, did you come up with that
23 or was that, was that suggestion planted in
24 your mind?

25 A. No, that's from my forty years of

1 experience in the adhesive industry, because
2 measuring thickness can be very difficult at
3 times, so whenever there's a dispute about
4 thickness, then we go to weight because
5 weight, there's no question about weight.

6 That's why I went to weight,
7 that's why I went down the road I went on,
8 basically because my experience in the
9 adhesive industry, we've seen it time and
10 time again, when a person makes a product
11 they will say I want X mils of thickness,
12 nine times out of ten they will say it will
13 have a certain weight.

14 Q. But this patent doesn't say that?

15 A. That's correct.

16 Q. And in fact putting aside your forty
17 years of experience, how about your one year
18 of experience in studying the '480 patent,
19 can we focus on that?

20 A. Sure.

21 Q. And you've agreed that the '480
22 patent treats the polymer layer as to
23 thickness?

24 A. Correct.

25 Q. Not area, not mass?

1 A. Correct.

2 MR. COHN: Objection.

3 MR. WEBER: But thickness?

4 MR. COHN: Objection.

5 THE WITNESS: Correct.

6 BY MR. WEBER:

7 Q. And while you as a person of
8 extraordinary skill in the art know, well,
9 what I can do is I can take area and I can
10 take mass and I can then extrapolate, that
11 isn't what the, the patent doesn't make
12 mention of that, does it?

13 MR. COHN: Objection.

14 THE WITNESS: Correct.

15 BY MR. WEBER:

16 Q. Okay. In fact the construction that
17 the Court issued as a matter of law in this
18 case does not limit the term "significant" to
19 weight, does it?

20 A. I believe you are correct.

21 Q. And the construction ruled by the
22 Court does not limit the word "significant"
23 to area, does it?

24 A. You are correct.

25 Q. In fact the construction ruled by the

1 Court doesn't limit the term "significant" at
2 all, does it?

3 A. Correct, it does not specify what it
4 means by "significant."

5 Q. Okay. Now, the claim limitations,
6 the claim itself speaks of thickness,
7 correct?

8 A. Uh-huh.

9 Q. And thickness correlates to the
10 cross-sectional height of the polymer layer,
11 doesn't it?

12 A. Yes.

13 Q. And a step is normally considered in
14 the context of height, isn't it?

15 A. Yes.

16 Q. Okay. You remember Neil Armstrong
17 and the small step and large step?

18 A. Right.

19 Q. The steps in your house, those all
20 get you from one level to another in this
21 incremental effort, but you didn't address
22 step in the context of height, did you, in
23 your report?

24 A. Yes, I did, in my calculations I
25 did.

1 Q. Okay. In what calculation, in the
2 percentages, the greater than ninety-five
3 percent?

4 A. Not in that one, but if you look at
5 the power point, I have a diagram in there
6 where the actual height of the step is used
7 in the calculation to calculate the area.

8 Q. Oh, okay. But when you did your
9 conclusions, you don't have any conclusions
10 drawn to the height of the step, do you?

11 A. No, I based mine on, as I said
12 before.

13 Q. You purposely disregarded addressing
14 the relative height of the step to the
15 overall height of the cross-section of the
16 product?

17 A. No, I did not.

18 Q. But you did disregard it, didn't
19 you?

20 A. No, I did not.

21 Q. Okay. What percentage is the step to
22 the overall thickness?

23 A. According to Mr. Lowe it's --

24 Q. No, according to your report?

25 A. I did not report, I did not report

1 that in my report.

2 Q. Thank you.

3 A. But when I did my calculations I did
4 consider it.

5 Q. Because had you reported it in your
6 report you would have said that step is about
7 sixteen percent of the thickness, wouldn't
8 you?

9 A. No.

10 Q. You wouldn't? What percentage would
11 it have been?

12 A. According to Mr. Lowe it's eighteen
13 and a half.

14 Q. Eighteen and a half percent?

15 A. According to Mr. Lowe.

16 Q. And you have no reason to believe Mr.
17 Lowe couldn't do that calculation?

18 A. It's simple math.

19 Q. But you didn't bother to do it, you
20 relied on Mr. Lowe, is that your testimony?

21 A. I relied on his number.

22 Q. Okay. Now, you considered the term
23 "significant" as to steps, you know the Court
24 used the term "significant" in association
25 with steps, you didn't address the functional

1 significance of the steps in the accused
2 product, did you?

3 A. In my mind I did, yes.

4 Q. But not in your report?

5 A. Correct.

6 Q. Okay. You understood that Mr. Lowe
7 thought that the function, that those steps
8 were functionally quite significant, didn't
9 you?

10 A. Yes.

11 Q. Okay. Looking at page five of your
12 report, down near the bottom you're talking
13 about the ARDL report, who do you know at --

14 A. The last paragraph?

15 Q. Yes, I apologize, the one bridging
16 the two pages.

17 A. I see it.

18 Q. Who do you know at ARDL, anyone?

19 A. No.

20 Q. Do you know anyone at Chemsultants?

21 A. Yes.

22 Q. Who do you know there?

23 A. Gary Avalon.

24 Q. Anyone else?

25 A. I remember the owner.

1 Q. Do you remember his name?

2 A. Dick Muny, M-U-N-Y, and also Mauser,
3 I think it's Richard Mauser, M-A-U-S-E-R I
4 think.

5 Q. Now, have you known these people for
6 a while?

7 A. I've known Gary for a long time and
8 Muny.

9 Q. Have you done any consulting or had
10 any discussion with them with regards to this
11 case?

12 A. No.

13 Q. Have you done any consulting or had
14 any discussions with ARDL with regard to this
15 case?

16 A. No.

17 Q. You're looking at the test report of
18 ARDL in the paragraph that I directed your
19 attention to, you say it states that peel
20 adhesion of the accused Superior Mark
21 product varies between 2.3 pounds per inch
22 and 6.1 pounds per inch, did I read that
23 correctly?

24 A. Yes.

25 Q. How do you account for that

1 variation?

2 A. That was related to the rate of peel.
3 When they measured the product, they measured
4 it two inches a minute, six and twelve, they
5 measured at three different peel rates and so
6 that's the range.

7 Q. Do the patent claims address peel
8 rate range?

9 A. Indirectly.

10 Q. Okay.

11 A. When they reference the test method,
12 the test method specifies the peel rate.

13 Q. Well, the patent, they cite the wrong
14 test method here, haven't they, 101D, that's
15 not the right test method?

16 A. One skilled in the art would have
17 used 101F but 101D can be modified and
18 that's what it states, they used a modified
19 method. And therein lies the confusion, did
20 they modify 101D to be more like 101F or is
21 it a typo.

22 Q. Okay, when you say therein lies the
23 confusion, what do you mean the confusion?

24 A. Over the method that's reported here.
25 Now if you were to give this to a lab and say

1 test the peel, they would look at that and
2 say, oh, 101D, I think they meant 101F so
3 they would use 101F.

4 Q. If you had given this to an
5 individual who was a banker, what would you
6 expect him to think?

7 MR. COHN: Objection.

8 THE WITNESS: The banker wouldn't
9 know 101D from 2000D.

10 BY MR. WEBER:

11 Q. Or an accountant?

12 A. Same thing.

13 MR. COHN: Objection.

14 THE WITNESS: Or a lawyer, same
15 thing.

16 BY MR. WEBER:

17 Q. Well, I wouldn't say that, I happen
18 to have an engineering degree.

19 A. Okay, well, so you know the
20 difference.

21 Q. Right.

22 A. So you have --

23 Q. Because when I looked at it I thought
24 I need to check the standard?

25 A. Good for you.

1 Q. Well, it's too bad, isn't it too bad
2 that the people who wrote this, to give these
3 teachings to the public, didn't edit it more
4 closely?

5 MR. COHN: Objection.

6 THE WITNESS: Yes.

7 BY MR. WEBER:

8 Q. Thank you. In fact when I look at
9 this, looking at peel strength it says in
10 claim two, let's jump to Exhibit 53, claim
11 two.

12 A. That's the claim sheet again?

13 Q. Yeah, if you go down, you know where
14 the claims are, claim two, go down to line
15 37.

16 A. Got it.

17 Q. It says where the adhesive tape has a
18 peel adhesion greater than two pounds per
19 inch width, when you read this patent you
20 didn't see anything in that patent that gave
21 a basis for two pounds per inch width pull,
22 did you?

23 MR. COHN: Objection.

24 THE WITNESS: What do you mean
25 basis, the rationale for picking two?

1 MR. WEBER: Well, two isn't
2 mentioned in any any of these, is it, can you
3 find where two pounds per inch width is
4 mentioned, where three pounds per inch width
5 is mentioned?

6 MR. COHN: Do you mean to ask him
7 one question?

8 BY MR. WEBER:

9 Q. Can you find a basis in the '480
10 patent specification for a two pound per inch
11 width peel?

12 A. You want me to take the time to read
13 to see if it's there?

14 Q. Well, it's either going to be there
15 or it's not?

16 A. Right, it's either there or not.

17 Q. Do you recall seeing that when you
18 read the patent specifications?

19 MR. COHN: Objection.

20 THE WITNESS: I don't recall, I
21 do not recall seeing that, I saw five in
22 there.

23 BY MR. WEBER:

24 Q. Yeah, because if you look at the
25 chart that bridges columns three and four,

1 look at the very last entry on column three,
2 it says adhesion to stainless pounds per inch
3 width.

4 A. I've got you.

5 Q. Pounds per inch width, now go up to
6 the top where it continues, and we've got
7 inventive sample, we have 5.2, standard
8 deviation of point five, do you see that?

9 A. Yes.

10 Q. That's testing that was done and they
11 came up with 5.2 with a standard deviation of
12 point five, what's that standard deviation
13 mean?

14 MR. COHN: Objection, you keep
15 giving prefaces and then going to questions.

16 BY MR. WEBER:

17 Q. Okay, so let's -- do you understand
18 this chart to be talking about the inventive
19 sample as having a 5.2 pounds per inch width
20 adhesion to stainless?

21 A. Okay.

22 Q. You understand that?

23 A. Yes.

24 Q. Okay. And it describes above the
25 tests that were undertaken, right?

1 A. Uh-huh.

2 Q. So it says 5.2 was an average with a
3 point five standard deviation, is that your
4 understanding?

5 A. Yep.

6 Q. Okay. And five test samples were
7 run, is that what the five is there?

8 A. Yes.

9 Q. Now, the 5.2 is more than double two
10 pounds per inch width, right?

11 A. Yes.

12 Q. Okay. And you don't -- let me ask
13 you what the standard deviation of point five
14 means?

15 A. That means this adhesion would vary
16 between 4.7 and 5.7.

17 Q. So plus or minus point five?

18 A. Standard deviation, yes.

19 Q. So you're saying what, you might be
20 as low as 4.7?

21 A. No, what it says in this series of
22 five measurements, the population of data
23 would fall in the 4.7 to 5.7 range.

24 Q. Okay, with an average then of 5.2?

25 A. 5.2.

1 Q. So there's no basis at least in this
2 chart for peel adhesion of two pounds per
3 inch width, right?

4 MR. COHN: Objection.

5 THE WITNESS: Are you asking me
6 the rationale for why you picked two, is that
7 your question?

8 BY MR. WEBER:

9 Q. Well, let's do that one next, okay,
10 let's answer my question first.

11 A. All right, so your question, say it
12 again please?

13 Q. Is there any basis in that, in the
14 patent or in that chart for the two pounds
15 per inch width?

16 A. No.

17 Q. Okay. All right, what's the
18 rationale, I'll bite, what's the rationale?

19 A. I don't know.

20 Q. Okay. Next time offer me a question
21 that you know the answer to, okay?

22 A. I mean he was the inventor, he
23 decided he wanted two, so he picked two.

24 Q. Okay. Inventors do those things?

25 A. Absolutely.

1 Q. All right. Let's look at page seven
2 of your report.

3 A. The same report?

4 Q. Yes, yes. Here at section B you're
5 saying the Superior Mark products infringe
6 claims two to four because the differences
7 are insubstantial to a person having ordinary
8 skill in the art, correct?

9 A. Uh-huh, yes.

10 Q. Now I apologize if I'm repetitious of
11 what we've discussed earlier but I want to
12 try to wrap it up here.

13 You've concluded that the
14 Superior Mark tapes or the accused tapes do
15 not have a layer of non-adhesive material
16 with adhesive on both sides, correct?

17 A. Yes.

18 Q. Okay. And to find infringement
19 you've determined that the layer of
20 non-adhesive material is unnecessary,
21 correct?

22 A. Right.

23 MR. WEBER: Okay.

24 (Discussion had off the record.)

25 MR. WEBER: Let's mark this.

1 (Defendant's Exhibit
2 No. 55 was marked
3 for identification.)

4 BY MR. WEBER:

5 Q. I've handed you what's marked as
6 Exhibit 55, are you familiar with that
7 exhibit?

8 A. The first time I'm seeing it.

9 Q. Okay. It talks about different Shore
10 assessments, in fact take your time and look
11 it over.

12 A. (Doing as requested.)

13 Q. Did you read it over?

14 A. I scanned it.

15 Q. Is there anything that jumped out at
16 you that you would disagree with?

17 A. No, it's typical sales literature.

18 Q. Okay. Shore was the name of a
19 company, wasn't it?

20 A. I'm not sure.

21 Q. Okay. It says in the first sentence
22 there, "Hardness is defined as a material's
23 resistance to indentation when a static load
24 is applied," did I read that right?

25 A. Yes.

1 Q. And that's true, correct?

2 A. Yes.

3 Q. By static load, what do you
4 understand that to mean?

5 A. Dead weight.

6 Q. Dead weight, just setting there, not
7 impacting it, no momentum, no velocity,
8 nothing, right?

9 A. Right.

10 Q. Okay. And the common instrument is
11 the Shore durometer, correct?

12 A. Yes.

13 Q. Now, down in the next sentence it
14 says, "A zero reading indicates that
15 penetration depth was at its maximum; a
16 reading of 100 specifies there was no
17 penetration."

18 So that would mean that you go
19 from, as you go from zero to a hundred, the
20 material is getting harder and more resistant
21 to penetration, correct?

22 A. Yes.

23 Q. And then there's three scales, at
24 least here there's a Shore A, a Shore D and a
25 Shore 00, are you familiar with those three

1 scales?

2 A. The A and D.

3 Q. The A and D, you're not familiar with
4 the double aught?

5 A. Right.

6 Q. Okay. And those are shown in a chart
7 or graph form almost in the center of Exhibit
8 55, right?

9 A. Right.

10 Q. And do you understand the Shore A and
11 Shore D scales to be linear scales, they're
12 not logarithm?

13 A. They're within themselves.

14 Q. Right, okay, so their increments are
15 uniform, correct?

16 A. They call them Shore units.

17 Q. Okay. And it's the same distance
18 going from zero to twenty as from twenty to
19 thirty?

20 A. Correct.

21 Q. And from thirty to forty?

22 A. Correct.

23 Q. And you understand what I mean by a
24 logarithmic scale, correct?

25 A. Uh-huh.

1 Q. Okay. So these are linearly
2 incremental and if we go here to the second
3 paragraph, it says the Shore A scale is the
4 most common scale for TPE's, what's a TPE?

5 A. Thermoplastic elastomers.

6 Q. Okay. And a Shore A durometer
7 consists of a blunt indenter with moderate
8 spring force, you agree with that, right?

9 A. Uh-huh.

10 Q. And what happens is this blunt
11 instrument, which is biased by a spring, as
12 penetration is made there is deflection,
13 correct?

14 A. Uh-huh.

15 Q. And that deflection will read
16 somewhere on the Shore chart --

17 A. Yes.

18 Q. -- correct?

19 A. Yes.

20 Q. It's my fault, not yours, we need to
21 not talk over each other.

22 A. Okay.

23 Q. You need to answer audibly and we
24 don't talk over each other because then he'll
25 get up and walk out.

1 A. Okay.

2 Q. Now, it says Shore A instruments are
3 less accurate when readings are above 90, and
4 that's true, isn't it?

5 A. Possibly.

6 Q. Okay. Because getting up to 90,
7 you're pretty much right at the end of the
8 scale, correct?

9 A. Yes, 90 is close to 100.

10 Q. Okay. And so what does the person
11 who really knows what he's doing with a, and
12 he's measuring the hardness of a material
13 with a durometer, do when he's getting up
14 close to 100 on a Shore A scale?

15 MR. COHN: Objection.

16 THE WITNESS: I can't answer what
17 a person would do.

18 BY MR. WEBER:

19 Q. You wouldn't know?

20 A. Well, I don't know what someone else
21 is going to do.

22 Q. What would you expect a person to
23 do?

24 MR. COHN: Objection.

25 THE WITNESS: I can't answer what

1 I would expect a person to do, I mean I can
2 only answer for what we do in ours, what
3 we've done in the past.

4 BY MR. WEBER:

5 Q. What have you done in the past then?

6 A. If we're doing a measurement like
7 this and we had all our history on a Shore A,
8 we stay with a Shore A.

9 Q. Okay, you'd stay with a Shore A, all
10 the history --

11 MR. COHN: He's still talking and
12 you --

13 BY MR. WEBER:

14 Q. And I apologize, were you done with
15 your answer?

16 A. If we have the historical data that
17 was completed with a Shore A, then we would
18 stay with a Shore A, we wouldn't change.

19 Q. Although you would know that you
20 would probably get better resolution by going
21 to a Shore D, correct?

22 A. If you needed better resolution, you
23 are correct, you'd get better resolution in
24 the mid range.

25 Q. Okay. And why is that?

1 A. Simply because you have more spread.

2 Q. Sure, so you get better resolution,
3 correct?

4 A. Well, yes and no. And the reason I
5 say yes and no is because when you look at
6 the actual tip of the, of the probe that goes
7 down into the, into the polymer, into the
8 layer, in the case of the soft material it's
9 flat and round, I think it's about .78
10 millimeters or .8 millimeters in diameter and
11 only has .8 gram load, it has a .8 pound load
12 on it, so it's very low.

13 So you've got a bigger surface
14 area that you're dealing with, which is
15 better because now you're spreading the load
16 out, you disperse the forces, versus the
17 Shore D, which is a more pointed probe, and
18 I'm trying to remember the radius, I can't
19 recall but it's a very blunt probe, so you're
20 looking at a smaller area.

21 Q. No, it's a very sharp probe?

22 A. Well, okay, I'm not going to argue.

23 Q. Well, no, I apologize --

24 A. The radius is there.

25 Q. Okay.

1 A. It's sharp relative to the flat.

2 Q. Okay.

3 A. So I forget what the radius is, then
4 that has a ten pound load. Now the rationale
5 is if you've got the flat foot, it's going to
6 be harder to push into a hard material. And
7 with only an eight, I think it's a point
8 eight pound load on it, it's hard to push, so
9 that's why they went to the more rounded
10 probe and a heavier weight.

11 So with that said, can I say
12 that it's going to be better? I would say,
13 you know, the rationale, our rationale would
14 be not to change to Shore D if we had the
15 history at Shore A.

16 If we were starting fresh,
17 with a new material, and if we knew what the
18 hardness was, we would probably make some
19 measurement and then make the decision which
20 probe to use.

21 Q. Okay. Yeah, you would you want the
22 probe to be consistent throughout, correct?

23 A. Absolutely.

24 Q. Particularly if you're looking for
25 how things might change or deviate?

1 A. Right.

2 Q. Do you agree with the statement down
3 in the third paragraph of Exhibit 55 that
4 says instantaneous readings typically give
5 higher, or harder, results than delayed
6 readings?

7 A. To me that's a fair statement.

8 MR. WEBER: Okay. Why don't we
9 take a short break and I'm very close to
10 being done, probably another twenty minutes
11 or so.

12 - - -

13 (Short recess had.)

14 - - -

15 (Defendant's Exhibit
16 No. 56 was marked
17 for identification.)

18 BY MR. WEBER:

19 Q. I've handed you, Mr. Serra, what's
20 been marked as Exhibit 56, have you seen this
21 document before?

22 A. I saw part of this yesterday.

23 Q. Okay, just yesterday, is that
24 correct?

25 A. Yes.

1 Q. Okay. Now this was filed in the
2 Patent Office on May 8th of this year, but
3 you saw it for the first time yesterday?

4 A. Yes.

5 Q. Okay. Now, looking at page ten of
6 this document, numbered page ten, it's
7 probably the eleventh page but you'll see the
8 paragraph that bridges pages ten and eleven,
9 it says, "In other words, across all uses,"
10 et cetera, do you see that?

11 A. Yes.

12 Q. Did you participate at all in the
13 preparation of that paragraph and submission
14 to the Patent Office?

15 A. Let me read it quickly.

16 Q. Sure, sure, take your time.

17 A. (Doing as requested.)

18 You know, I did read the
19 Kjellqvist patent but I don't recall ever
20 writing or working on that paragraph.

21 Q. Okay. And would the first time that
22 you would have seen that paragraph been
23 yesterday, to the best of your knowledge?

24 A. To the best of my knowledge, yes.

25 MR. WEBER: Okay. I'll ask the

1 Reporter to mark this as Exhibit 57.

2 (Defendant's Exhibit

3 No. 57 was marked

4 for identification.)

5 BY MR. WEBER:

6 Q. Now, do you recognize Exhibit 57?

7 A. Yes, I believe this is the one I read
8 many, many months ago.

9 Q. Okay. And you recognize this patent
10 as dealing with floor, wall or ceiling
11 coverings, correct?

12 A. Yes.

13 Q. Okay. And that they used a polymer
14 as a body of the coverings, the polymers?

15 A. Yes.

16 Q. Obviously you can look at whatever
17 you want to look at to refresh yourself a
18 little if you'd like to but if you'll go to
19 column 13, around line four, the paragraph
20 that begins, "The floor, wall or ceiling
21 covering of the present invention," do you
22 see that?

23 A. Yes.

24 Q. Did you ever convert those
25 measurements from metric to English?

1 A. I believe I did.

2 Q. Okay. And when you did you found out
3 that those thicknesses fell within the
4 claimed range of the '480 patent?

5 A. I don't know what the data is.

6 Q. Okay.

7 A. But I think I did, I think I do
8 remember converting those.

9 Q. Okay. And the conversion would be
10 what, how many centimeters in an inch?

11 A. 2.54.

12 Q. Okay, so if you take 2.54 centimeters
13 per inch?

14 A. You normally use 25.4 and do the
15 math.

16 Q. Right, 25.4, you use the factor label
17 method, do you remember the factor label
18 method?

19 A. Before my time.

20 Q. Okay, all right, but you can easily
21 convert, right?

22 A. Yes.

23 Q. Okay. And then it will tell you
24 whether or not those measurements do fall
25 within the --

1 A. Correct.

2 Q. -- range of the claims, correct?

3 A. Correct.

4 Q. Okay. And down at column 15, around
5 line 59.

6 A. Okay.

7 Q. It talks about, you know, common
8 adhesives, generally common adhesives such as
9 acrylic or styrene, butadiene based adhesives
10 can be used to fix the coverings to floor,
11 ceiling or walls, correct?

12 A. Yes.

13 Q. Okay. And you understand that to be
14 a teaching of this patent, right, that's what
15 the patentee is saying, that you can use
16 those types of adhesives?

17 A. If that's what you mean by teaching,
18 yes.

19 Q. Okay. And then it's saying to use
20 those types of adhesives basically because
21 you don't need a primer, correct?

22 A. He's saying that.

23 Q. Okay. Do you recall looking at these
24 examples, one to thirty-three, starting in
25 column twenty of this patent?

1 A. Column twenty?

2 Q. Yeah, column twenty, if you look down
3 there around line 25 or 22 it says examples
4 one to thirty-three?

5 A. Yes, I see that.

6 Q. Okay. Did you look at those various
7 examples.

8 A. Yes, I did, I scanned those.

9 Q. Okay. And if you look at those
10 examples, they're charted out then on the
11 next couple of pages, the thirty-three, and
12 the Shore A hardness of those examples are
13 given in the chart, right?

14 A. Yes.

15 Q. Okay. And those are whatever they
16 are, correct, I mean you and I can't change
17 that?

18 A. Correct.

19 Q. And a lot of those fall in the range
20 of 92 to 100, don't they?

21 A. Yes.

22 Q. And 92 to 100 is the range set forth
23 in the '480 patent, correct?

24 A. Yes.

25 Q. And if you went back and did the

1 conversion, factor and label method or
2 otherwise in column thirteen of the patent
3 that we talked about, you wouldn't be
4 surprised that the thicknesses of the patent
5 also fall within those ranges, would you?

6 MR. COHN: Objection.

7 THE WITNESS: You're saying go
8 back to column thirteen and do these
9 conversions?

10 BY MR. WEBER:

11 Q. Yeah, if you did those conversions?

12 A. I'd say some of them would probably
13 fall within that range.

14 MR. WEBER: Okay. I'm going to
15 ask, what I've got here, counsel, is an
16 exhibit that you marked this morning as
17 PX 24, do you want me to, I mean I'm happy
18 to, I'll put a D exhibit on it as well.

19 MR. COHN: It's your record, do
20 whatever you want.

21 MR. WEBER: Okay, well, I just
22 don't want to confuse you. This is PX 24 and
23 we'll call it DX 58.

24 (Defendant's Exhibit

25 No. 58 was marked

1 for identification.)

2 BY MR. WEBER:

3 Q. I've handed you what's been marked as
4 Exhibit 58, which is an office action from
5 the ex parte re-examination, have you seen
6 this before?

7 A. I saw this late yesterday.

8 Q. Late yesterday?

9 A. Yes.

10 Q. Okay. And did you study it?

11 A. No, I read it very quickly.

12 Q. Okay. So you didn't form any
13 opinions as to whether the examiner was right
14 or wrong?

15 A. No, I did not.

16 Q. Okay. So yesterday was the first
17 time that you ever saw Exhibit 56 or 58; is
18 that correct?

19 A. Yes.

20 Q. Okay. Now, did you see that for
21 purposes of your deposition today or just for
22 your own edification?

23 A. For information.

24 Q. Just for information?

25 A. Yes.

1 Q. Okay. You have several patents,
2 correct?

3 A. Yes.

4 Q. Okay. And you understand that as a
5 patent applicant you have a duty of candor
6 with the Patent Office, correct?

7 A. Yes.

8 Q. Okay. And what does that duty of
9 candor require?

10 MR. COHN: Objection.

11 BY MR. WEBER:

12 Q. To satisfy that duty of candor?

13 A. You have to tell the Patent Office
14 what you know about the invention, disclose
15 to them what your invention is and supply
16 them with any information that you have for
17 your application, at the time of the
18 application, as well as if you have any prior
19 references, you have to submit all that as
20 well.

21 Q. So prior art references or prior art
22 information, correct?

23 A. Right.

24 Q. And you understand that you can't
25 play games with the Patent Office during the

1 prosecution, correct?

2 A. Correct.

3 MR. COHN: Objection.

4 BY MR. WEBER:

5 Q. And you can't make representations
6 or statements to the Patent Office that you
7 know you couldn't make if the Patent Office
8 knew things that you knew, is that fair to
9 say?

10 MR. COHN: Objection.

11 THE WITNESS: Say that once
12 again?

13 BY MR. WEBER:

14 Q. Okay. If you know of prior art that
15 you have not disclosed to the Patent Office
16 and if that prior art would have been
17 material to claims that you were presenting
18 to the Patent Office --

19 A. Yep.

20 Q. -- that would be a violation of your
21 duty of candor, wouldn't it?

22 A. Yes.

23 Q. Okay. And then if you made arguments
24 to the Patent Office that you can only make
25 because you know the Patent Office doesn't

1 know of the prior art that you're holding
2 back, that's also a violation of that duty,
3 correct?

4 A. Yes.

5 Q. Okay. And you know that from dealing
6 with your patent attorney and prosecuting
7 patents, correct?

8 A. Yes.

9 MR. WEBER: I think I'm done, I
10 appreciate your courtesy and your patience.

11 THE WITNESS: You're welcome.

12 MR. COHN: We're not quite done
13 though.

14 - - -

15 BY MR. COHN:

16 Q. In your report, which was marked in
17 this deposition as I think Exhibit 54.

18 A. Got it.

19 Q. In your discussion of claim five,
20 I'll draw your attention to where that was,
21 I'm talking about the reference to the
22 thickness?

23 A. Claim five starts on page three.

24 Q. I think we were on page seven.

25 A. Okay.

1 Q. In answer to some of Mr. Weber's
2 questions regarding the measuring of the
3 thickness of the accused product and the
4 measurements that you did, you indicated
5 that you wanted to talk about the weight, do
6 you recall that?

7 A. Yes.

8 Q. Please explain what it was about the
9 weight that had meaning to you in connection
10 with measuring the thickness?

11 A. Because the thickness measurement,
12 depending on how it's measured, and there
13 are different tools used to measure, there's
14 what they call a snap gauge, which is a
15 handheld gauge.

16 And when you use that handheld
17 gauge you can get some variation because you
18 literally pull the trigger, it raises the
19 presser foot, which then when you release it
20 it comes down and touches it.

21 And there's no set dwell time,
22 there's no set pressure on it, and so you can
23 get some variation. Although it's still used
24 in the industry today as a means of measuring
25 thickness, however, it's not one of the best

1 ways to do it.

2 Then there's the, then there's
3 the automated kind, which is, it's a
4 mechanical one, it has an anvil and a presser
5 foot that can, given area, given weight,
6 given time, coming down and touching the
7 product, and so it's a better test for
8 thickness. But even that has some error in
9 it.

10 So when you really want to
11 understand the thickness of your product,
12 you always go to weight per unit area,
13 because that nails it and there's no question
14 about it. That is, that's the way the
15 industry does it.

16 That's why I went to weight,
17 because I knew it eliminated all those other
18 issues because it's based, it's based on the
19 polymer that you've used.

20 Q. So when you use the weight as a way
21 to measure thickness, were you taking into
22 account the language of claim five?

23 MR. WEBER: Objection. Go ahead.

24 THE WITNESS: Well, when you use
25 weight to measure it, it's based on weight,

1 it's the physical amount of material there,
2 so in that sense you take into account that
3 recess or step, whatever we're calling it.

4 When I did the area
5 calculation, and if you look at that -- well,
6 let me rephrase that.

7 The weight measurement, the way
8 the weight measurement was conducted, that
9 step was cut out of the sample. So the step
10 weight was actually part of the analysis,
11 just that little step. So that, that was
12 weighed individually.

13 So by doing that you have the,
14 you have the total material there, in which
15 case you have the thickness there, okay. And
16 then when I did the area measurement, and if
17 you look at the exhibit that I included --

18 MR. WEBER: Are you just
19 anticipating his next question?

20 THE WITNESS: No, because I was
21 talking about area, because I did it three
22 ways.

23 MR. WEBER: All right, did you
24 hear your counsel's question?

25 THE WITNESS: The question was?

1 MR. COHN: Do you want to make me
2 ask it or do you just want to --

3 MR. WEBER: Well, you guys have
4 obviously rehearsed this quite well, so go
5 ahead, I'm anxious to hear this.

6 THE WITNESS: Well, I take
7 objection if you think we rehearsed this
8 because we didn't.

9 MR. WEBER: Well, what I take
10 objection to is you didn't measure the height
11 or the -- you measured it but you didn't put
12 it in the report, that's what I take
13 objection to.

14 MR. COHN: Well, we're about to
15 show you.

16 MR. WEBER: Go ahead.

17 THE WITNESS: We'll show you, if
18 you go over to this chart and you look at
19 this little triangle, the height from Mr.
20 Lowe's declaration where he has all his
21 diagrams, that's the height I used.

22 MR. WEBER: Go ahead.

23 THE WITNESS: So I used that and I
24 did a first approximation to calculate the
25 contribution using that height and that's

1 what I presented in my, in my declaration.

2 BY MR. COHN:

3 Q. And just to be clear, the testimony
4 you've just given about the use of weight in
5 measuring thickness, is your work in that
6 regard shown in the report somewhere?

7 A. The summary is.

8 Q. Where is that?

9 A. That was in here, that was given,
10 because I did it, I wanted to be thorough so
11 I did it two ways to see if I could get a
12 correlation, and that's why I was going to
13 the other one, sir.

14 Q. We're going to get to that but for
15 purposes of what you were saying about
16 weight?

17 A. What page were we on, it's close to
18 that?

19 Q. Page seven?

20 A. I know it's in here. Yeah, right
21 here, go to page five and that first
22 paragraph, about the one, two, three, four,
23 five, sixth line down.

24 It says I have calculated that
25 the features identified by the numbers,

1 quote, 32, end quote, in the above figure,
2 which is figure one, account for less than
3 one percent of the overall weight of the
4 polymer, roughly 0.039 percent for a four
5 inch wide tape.

6 Q. And then you go on to refer to an
7 exhibit?

8 A. Yeah, that's the --

9 Q. Where you were reading from?

10 A. Yeah, over here.

11 Q. Page five, where you were reading, is
12 there a reference to an exhibit?

13 A. I said these are summarized in
14 exhibit 3, so if you go to exhibit 3, the
15 weight calculation is there.

16 Q. And I didn't want to cut you off but
17 I'm ready to move onto area. How did you do
18 area in determination of thickness?

19 A. The area, I then took the diagrams
20 from Mr. Lowe's report and I then did as I
21 said, a first approximation of that area. I
22 didn't get into a lot of math, so I treated
23 it as basically a rectangle and triangle.

24 And what I found doing it both
25 ways, I had pretty good correlation so I

1 stopped at that point, I didn't go any
2 further. If you compare the area measurement
3 versus the weight measurement, they're fairly
4 close to each other and I said that's a
5 pretty good indication of the contribution of
6 that step or recess to the product.

7 So that was my rationale for
8 doing it that way. And the reason I did area
9 was to see if I could verify the weight
10 measurement.

11 Q. And it was pointed out to you that
12 Judge Nugent in his claim construction used
13 the word "significant" in talking about the
14 substantially uniform thickness, Exhibit 52.

15 The bottom of page eleven,
16 this is your copy of Exhibit 52, there's a
17 sentence where the Judge gives his ruling on
18 the meaning of substantially uniform
19 thickness and he talks about without
20 significant deviations, protrusions or
21 steps.

22 Did your calculation of weight
23 and/or area have any relationship in your
24 mind to whether or not the accused product
25 had significant deviations, protrusions or

1 steps?

2 A. That's why I did the calculation, I
3 wanted to see if in fact we did have, quote,
4 significant, end quote, contributions to the
5 product.

6 Q. And in using those calculations with
7 regard to the word "significant," why did
8 you, as someone who has worked with these
9 tapes, why would you use weight or area to
10 measure what is or is not significant in
11 terms of thickness?

12 A. If I understand the question, I did
13 the weight measurements because when you do
14 the -- if you only base it on thickness,
15 you're basing it on something that's only a
16 small area of the total product.

17 You're basing it, it's not
18 point, it's bigger than point but you're
19 basing it on a single or in this case double
20 because they're on each edge.

21 You are basing that deviation,
22 it's supposed to be across the whole sheet,
23 this is only on the edge and it's a small
24 amount of the edge. So I said if it's really
25 significant, I should see that reflected in

1 the overall product as well.

2 And so that's why I did the
3 calculations the way I did the calculations.
4 And again I did them two ways, to see if I
5 could, to see if I would get a reasonable
6 correlation.

7 Q. And on cross examination during this
8 deposition you were asked whether you
9 considered functionality in terms of the word
10 "significant." Are you familiar with what
11 the Defendant and its principal indicated the
12 functionality is of the step in each lateral
13 edge?

14 A. My understanding is that the step
15 prevents the adhesive from oozing out
16 underneath that edge.

17 And while I would disagree
18 with that, because this is a viscoelastic
19 material and if you have a forklift or if
20 you have a heavy weight that runs over the
21 edge and doesn't cover that step when it
22 hits it, just on the inside of that step,
23 the weight from that adhesive, the weight
24 from the forklift or whatever going over it
25 would, with time is going to force that

1 adhesive out from underneath that step, it's
2 going to ooze, it has to because it's a
3 viscoelastic material and with time that's
4 going to happen.

5 So while it may retard it or
6 slow it, with time it's going to ooze because
7 it's pressure sensitive.

8 MR. COHN: That's all I have.

9 - - -

10 BY MR. WEBER:

11 Q. So let me make sure that I
12 understand.

13 A. Okay.

14 Q. If we look at your expert report, can
15 you show me from an area standpoint what you
16 considered the step to be?

17 A. Sure. Do you have the page?

18 Q. Well, I want you to tell me.

19 A. Okay, go to the page titled "First
20 Approximation of Recess Contribution to Total
21 Polymer Layer Based on Area."

22 Q. Okay. Can you point to me?

23 A. Yes, if you look --

24 MR. COHN: Let him ask a question.

25 BY MR. WEBER:

1 Q. The element, the element, that was
2 the area of the step?

3 A. Yes, if you look at the exhibit, on
4 the bottom left-hand side of the page that
5 has the words detail A, scale thirty to one
6 on it, do you have that, right here.

7 Q. Okay. All right, yep.

8 A. You'll see the arrow that goes from
9 A, letter A, pointing to that triangle.

10 Q. So what you're calling a step is the
11 tapered edge, correct?

12 A. Yes.

13 Q. So you're looking at the area of the
14 edge from where the step actually -- above
15 the dimensions for where a step actually
16 occurred?

17 A. Yes.

18 Q. Because the rest of that triangle is
19 going down, right, that whole piece that you
20 have darkened in there is of varying height,
21 isn't it?

22 A. No, no, because according to Mr.
23 Lowe's diagram it's .027.

24 Q. You've colored in the whole wedge?

25 A. I did, because you can see it. But

1 if you look at Mr. Lowe's diagram without
2 the colored wedge, I did this so you can see
3 this thing, this height, this .027 came from
4 Mr. Lowe's diagram, that's not my number.

5 Q. I'm not saying it is.

6 A. Which represents the height, because
7 when he calculated the height, he took that
8 .027 and divided by the total and that's how
9 he got his eighteen and a half percent, so
10 that height is the same height Mr. Lowe used
11 in his calculation.

12 Q. Tell me again what you think Mr. Lowe
13 did?

14 A. When he calculated the overall
15 contribution of this, he based it on the
16 height of the step over the overall thickness
17 and that's how he got his eighteen percent, I
18 think it's eighteen and a half.

19 Q. And what was the height?

20 A. .027.

21 Q. That was the height of the step?

22 A. Yes.

23 Q. Okay. That's your testimony?

24 A. Yes, sir.

25 Q. Okay. And then what was the overall

1 thickness?

2 A. That is the thickness but it's not
3 overall, it's a step, it's on that taper.

4 Q. Well, a taper is a ramp, a step is a
5 --

6 A. Well --

7 Q. A step goes into a transition, an
8 instantaneous transition from one level to
9 other?

10 A. Correct.

11 Q. That's certainly how you understand a
12 step, right?

13 A. Yes.

14 Q. Okay. And tell me what you
15 understood the height of the step to be?

16 A. .027.

17 Q. And that was from where to where?

18 A. From the top of, from the -- how can
19 I describe it -- from the bottom of where
20 that step begins to the top of the step,
21 where it ends.

22 Q. Okay. And then what was the, say you
23 had .027 and what was it divided by or what
24 was the next number of concern?

25 A. Then what I had to figure out, what's

1 the width of it, so I could calculate the
2 area from that, because I'm treating it as a
3 triangle. And the width therefore again from
4 Mr. Lowe's statement, from his report, said
5 it was, I'm trying to read this upside down,
6 was .058.

7 So then from that I can now
8 calculate the area based on the height
9 divided by two of that triangle. Then that
10 represents the step on this side because it
11 mirrors the other side, so you have two, so
12 multiply times two, so then that tells me the
13 area of the step triangled.

14 Q. The ramp?

15 A. Okay, we'll call it a ramp.

16 Q. Okay.

17 A. In the product and then I divided
18 that by the total area of the product and
19 that's how I got my number.

20 Q. And you did the same thing in the
21 weight calculation, right, you cut off these
22 two ramps?

23 A. Yes.

24 Q. You measured their mass or weight?

25 A. Yes.

1 Q. And then you measured the mass or
2 weight of the entire unit, including the
3 ramps?

4 A. Less the adhesive, I took the
5 adhesive out.

6 Q. But of the entire polymer?

7 A. Right, the polymer layer, total
8 weight of the polymer layer was used in the
9 calculation, yes.

10 Q. Okay. And that was the denominator?

11 A. Yes.

12 Q. And the numerator was the?

13 A. The weight of that.

14 Q. The weight of the two ramps?

15 A. Correct.

16 Q. Okay. So but you understand I think
17 -- as a matter of fact I'm going to leave
18 your earlier testimony as it was, because
19 your earlier testimony was correct, wasn't
20 it?

21 A. Relative to? Everything that I said,
22 I said truthfully, everything I've said has
23 been truthful.

24 Q. And you reaffirm it, correct?

25 A. Yes.

1 Q. How deep was the recess in his
2 product, in Mr. Lowe's product?

3 A. .027.

4 Q. .027 was the depth of the recess,
5 correct?

6 A. It was the height of, what you're
7 calling the recess, I'm calling the step
8 here.

9 Q. We talked about the step, now I'm
10 talking, you understand his product has a
11 recess?

12 A. Yes.

13 Q. What's the depth of the recess?

14 A. That recess?

15 Q. Or the height of the recess?

16 A. Hang on here a second. That depth
17 would be the same as the height of the step
18 because this step comes above that recess.

19 Q. Okay. So you're saying the height of
20 the step is .027?

21 A. No, I'm saying Mr. Lowe says it's
22 .027, those are not my numbers.

23 Q. Because you never measured this?

24 A. No, I relied on what Mr. Lowe
25 provided.

1 Q. And you think what you've done here
2 is consistent with what Mr. Lowe provided and
3 what the claims say and what the Court said,
4 is that your testimony?

5 A. No, I'm saying to you, what I am
6 saying to you is what I did to try to
7 understand if this step made a significant
8 contribution to the product.

9 So I came up with this method,
10 these two methods, three methods, whatever
11 you're going to call it, to make that
12 determination and to form my opinion.

13 Q. Okay.

14 A. That's why I did that, because I
15 disagreed. Well, I understand Mr. Lowe's
16 calculation, I disagreed with that because it
17 didn't represent the whole product, it only
18 represented a point or a part of it and I
19 said I want to see what this step does
20 relative to the entire product, so that's
21 why I did it. And when I say the entire
22 product, I should say the polymer layer less
23 the steps.

24 Q. The significance of a step is
25 typically going from one level to another,

1 isn't it, that's what steps are used for?

2 A. Yeah.

3 Q. Okay. I mean that's what the steps
4 in your house do, correct?

5 A. Yes.

6 Q. And in fact the steps in your house,
7 there are generally about thirteen of them to
8 go on an eight foot or nine foot span, do you
9 understand that?

10 A. Yes.

11 Q. And the height of those steps or the
12 percentage height of those steps is about
13 half the percentage of the step that's in Mr.
14 Lowe's product, do you understand that?

15 A. I didn't do a calculation so I'd say
16 no, I don't understand that.

17 Q. Well, could you understand it?

18 A. If I did a calculation, yes.

19 Q. Now, we talked about ooze, you never
20 really tested Mr. Lowe's product for ooze,
21 have you?

22 A. No, I did not.

23 Q. Did you ever test the product that
24 ShieldMark makes for ooze?

25 A. Let me answer this, the two questions

1 differently. I did not run a physical test
2 as in a shear measurement or a real logical
3 measurement. I did do, excuse me for saying,
4 my finger test.

5 And since I know the chemistry
6 of the Goecke product, because it's a rubber
7 based adhesive, I know that's got less
8 tendency to flow than Mr. Lowe's product
9 because if you just put it between your
10 fingers you can feel the hardness or
11 softness, whatever you want to say.

12 I also in my opinion believed
13 that Mr. Lowe's product is a hot melt applied
14 product and by definition if it's a hot melt
15 applied product it's going to have less
16 adhesive drain and a tendency to ooze more
17 than the rubber based product that's on the
18 other product.

19 Q. And the non-adhesive layer or
20 membrane that's in Mr. Goecke's product also
21 precludes oozing, doesn't it?

22 A. Yes.

23 Q. Why didn't you tell me that without
24 me asking it?

25 A. Because I was concentrating on the

1 adhesive.

2 Q. Well, the non-adhesive membrane is a
3 part of the adhesive, isn't it?

4 A. Well, it's a part of the function of
5 the adhesive but if you talk about the
6 adhesive layer that's directly in contact
7 with the floor, I was addressing that
8 adhesive.

9 But you're absolutely correct,
10 the fabric that's the carrier for the
11 double-coated product does two things. One,
12 it keeps obviously the adhesive separate, and
13 the second thing, it also acts as a
14 reinforcing fabric between two adhesives.
15 But the ooze would be determined by working
16 the adhesive.

17 Q. And you didn't tell the Court
18 anything like you just told me when you did
19 your Doctrine of Equivalents analysis, did
20 you?

21 A. No, that was not in any of my reports
22 I don't think.

23 MR. WEBER: All right.

24 MR. COHN: One more question.

25 - - -

1 BY MR. COHN:

2 Q. Did anything in your last discussion
3 with Mr. Weber about the effect of the
4 adhesive on the possibility of oozing, did
5 any of that affect your conclusions regarding
6 whether the two adhesives have functional
7 equivalence?

8 MR. WEBER: Objection.

9 THE WITNESS: No, I mean the
10 adhesives will have similar performance, I
11 mean they will be different but they're going
12 to do the same thing, they're going to hold
13 that polymer layer onto the floor. The
14 function will be the same, different
15 characteristics but yes, they will do the
16 same function.

17 MR. WEBER: Are you done?

18 MR. COHN: Yes.

19 - - -

20 BY MR. WEBER:

21 Q. All of the adhesives mentioned in all
22 of the claims of the '480 patent will perform
23 that function, won't they, they will hold the
24 polymer layer to the floor?

25 A. I'm trying to recall all the

1 adhesives mentioned.

2 Q. Well, take your time and let's look
3 at them, if you look at all the claims of the
4 '480 patent, it's Exhibit 53, and tell me
5 which ones in there don't perform the
6 function of holding the polymer layer to the
7 floor?

8 A. I can't answer that.

9 Q. Because they all hold it to the
10 floor, right?

11 A. Yes, but for example in claim one it
12 says a layer of pressure sensitive adhesive,
13 the first side and second side, it doesn't
14 tell me the composition so I can't say is it
15 going to be good enough to hold it.

16 Q. So you think that might be claiming
17 an inoperative embodiment, is that your
18 testimony?

19 A. No, I didn't say that.

20 Q. To be an operative embodiment it
21 would have to hold it to the floor?

22 A. The question you asked me is can you
23 say that none of these, that one of these
24 adhesives will not function.

25 Q. Okay, the intention of each one of

1 the adhesives in every claim of that patent
2 is to hold?

3 A. Yes, correct.

4 MR. WEBER: Okay. Are you done?

5 MR. COHN: I am.

6 MR. WEBER: I want to thank you
7 for your courtesy and patience.

8 THE WITNESS: You're welcome.

9 - - -

10 (Deposition concluded at 1:25 o'clock p.m.)

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I, JERRY M. SERRA, Ph.D., do
verify that I have read this transcript
consisting of one hundred (100) pages and
that the questions and answers herein are
true and correct with corrections as noted on
the errata sheet.

JERRY M. SERRA, Ph.D.

Sworn to before me _____,
a Notary Public in and for the State of
_____, this ____ day of _____, 2013.

Notary Public in and for the
State of _____

My commission expires -----

Correction

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C E R T I F I C A T E

STATE OF OHIO,)
) SS:
SUMMIT COUNTY.)

I, Michael G. Cotterman, a Notary Public within and for the State of Ohio, duly commissioned and qualified, do hereby certify that the within named witness, JERRY M. SERRA, Ph.D., was by me first duly sworn to testify the truth, the whole truth and nothing but the truth in the cause aforesaid; that the testimony then given by the witness was by me reduced to Stenotypy in the presence of said witness, afterwards transcribed upon a computer; and that the foregoing is a true and correct transcription of the testimony so given by the witness as aforesaid.

I do further certify that this deposition was taken at the time and place in the foregoing caption specified, and was completed without adjournment.

I do further certify that I am not a relative, employee of or attorney for any of the parties in the above-captioned action; I am not a relative or employee of an attorney of any of the parties in the above-captioned action; I am not financially interested in the action; and I am not, nor is the court reporting firm with which I am affiliated, under a contract as defined in Civil Rule 28(D).

IN WITNESS HEREOF, I have hereunto
set my hand and affixed my seal of office at
Akron, Ohio on this 6th day of September,
2013.

Michael G. Cotterman, a Notary
Public in and for the State of Ohio.

My Commission expires October 25, 2017.

Bish & Associates, LLC
STENOTYPE REPORTERS

October 14, 2013

In Re: Shieldmark vs Insite
Deposition of Jerry Serra taken on August 30, 2013

To All Counsel:

Since the witness has not read and signed the transcript within the 30 days allowed under the Rules, signature is deemed to have been waived.

Respectfully,

Michael G. Cotterman
Court Reporter

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